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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/053,797 | 01/18/2002 | Mark C. Myrhum | 67175523.001101 | 4271 |
| 23562 7590 03/31/2008 BAKER & MCKENZIE LLP PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201 | | | | |
| EXAMINER BLAU, STEPHEN LUTHER | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3711 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 03/31/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/053,797

Applicant(s)

MYRHUM ET AL.

Examiner

Stephen L. Blau

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-107 is/are pending in the application.
- 4a) Of the above claim(s) 21-73,85-93,97,106 and 107 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 74-84,94-96 and 98-105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/14/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on 14 August 2007 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/053,797 is acceptable and a RCE has been established. An action on the RCE follows.

Election/Restrictions

2. Claims 97 and 106-107 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 28 January 2008.

Information Disclosure Statement

3. The information disclosure statement filed 14 August 2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because items 1 and 4 in Non-Patent Literature Documents do not have a date listed on the PTO/SB/08 which is required. It is uncertain if these references are prior art or not. It has been placed in the application file, but the information referred to therein for these two references have not

been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 74-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Ryan, and McCabe.

Vincent discloses a golf club assembly (Fig. 25) comprising a head having a crown (Fig. 11) fitting configured to receive an insert (Fig. 25) and a sole plate (Fig. 12) fitting configured to receive an insert (Fig. 25) producing a desired center of gravity and a head which will have an overall weight.

Vincent lacks a club having a plurality of possible centers of gravity, a crown weight insert, a sole weight insert comprising a weight configured to move the center of gravity vertically either up or down in conjunction with the crown insert without effecting

the overall weight of a head, and to have crown or sole weights being lighter, heavier, or medium.

Ryan discloses a club assembly having a plurality of possible centers of gravity (Figs. 10-11), heel and toe weight inserts with each insert comprising a weight configured to move the center of gravity without effecting the overall weight of a head in the form of placing either the heavy weights on one side of the head and light weights on the other side of the head (Figs. 10-11), and heel or toe weights being lighter, heavier, or medium (Figs. 10, 11 and 13) in order to be able to move the center of gravity (Abstract). McCabe discloses first setting the overall weight of a head and then adjust the vertical weight of a head in order to set the desired center of gravity location (Col. 5, Lns. 20-32). In view of the patents of Ryan and McCabe it would have been obvious to modify the club assembly of Vincent to have a club head having a plurality of possible centers of gravity, a crown weight insert, and sole weight insert comprising a weight configured to move the center of gravity vertically either up or down in conjunction with the crown insert without effecting the overall weight of a head and crown or sole weights being lighter, heavier, or medium in order to have a club which a player is able to select the desired center of gravity location in the vertical direction but still maintain an overall weight of a head.

6. Claims 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Ryan, and McCabe as applied to claims 74-80 above, and further in view of Wood.

Vincent lacks a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate.

Wood discloses a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole being recessed around an aperture so a fastener does not extend beyond the sole (Fig. 2) in order to have an adjustable lie (Col. 2, Lns. 13-25). In view of the patent of Wood it would have been obvious to modify the club assembly of Vincent to have a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate in order to have adjustable lie woods.

7. Claims 74-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Sahm, and McCabe.

Vincent discloses a club assembly (Fig. 25) with a head having a crown (Fig. 11) having a fitting configured to receive an insert (Fig. 25) and a sole plate (Fig. 12) fitting configured to receive an insert (Fig. 25) producing a desired center of gravity.

Vincent lacks a club having a plurality of possible centers of gravity, a crown weight insert, a sole weight insert comprising a weight configured to move the center of

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gravity vertically either up or down in conjunction with the crown insert without effecting the overall weight of a head, and to have crown or sole weights being lighter, heavier, or medium.

Sahm discloses a club having a plurality of possible centers of gravity, heel and toe weight inserts with each insert comprising a weight configured to move the center of gravity without effecting the overall weight of a head (Col. 5, Lns. 5-10, B,A,A and A,A,B configurations, Col. 7, Lns. 1-20) and weights being lighter, heavier, or medium (Col. 4, Lns. 34-36, 51-52) in order to change the mass distribution of a head (Col. 5, Lns. 1-4). McCabe discloses first setting the overall weight of a head and then adjust the vertical weight of a head in order to set the desired center of gravity location (Col. 5, Lns. 20-32). In view of the patents of Sahm and McCabe it would have been obvious to modify the club assembly of Vincent to have a club head having a plurality of possible centers of gravity, a crown weight insert, and sole weight insert comprising a weight configured to move the center of gravity vertically either up or down in conjunction with the crown insert without effecting the overall weight of a head and crown or sole weights being lighter, heavier, or medium in order to have a club which a player is able to select the desired center of gravity location in the vertical direction but still maintain an overall weight of a head.

8. Claims 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Sahm, and McCabe as applied to claims 74-80 above, and further in view of Wood.

Vincent lacks a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate.

Wood discloses a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole being recessed around an aperture so a fastener does not extend beyond the sole (Fig. 2) in order to have an adjustable lie (Col. 2, Lns. 13-25). In view of the patent of Wood it would have been obvious to modify the club assembly of Vincent to have a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate in order to have adjustable lie woods.

9. Claims 94-96, and 98-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Ryan, and McCabe as applied to claims 74-80 above, and further in view of Ashcraft (5,513,844).

Vincent discloses a shaft (Claim 39).

Vincent lacks a head having a bore, a fastener, a hosel fitting a first portion of a tubular structure configured to be affixed to the end of the shaft, a second portion of the tubular structure received by a bore in a head, a second portion extending downwardly

into a bore, a female fastener receiving portion for receiving a bolt fastener configured to affix a hosel fitting to a head, a bore, hosel fitting and shaft being in line, a second portion of the tubular structure contacts a base of a shaft receiving bore, a fastener allowing the exchange of different shafts, a recess below the bore so the fastener will not strike the ground, a wood type head, a bore having an aperture in the base and a fastener extends through the aperture to mate with the fastener receiving portion, a bore configured to orient a shaft properly when a shaft is connected to the head with the hosel fitting, a fastener configured to allow the head to be exchanged with different heads, and heads having different center of gravities.

Ashcraft discloses a hosel fitting (12) for connecting a shaft to one of a plurality of heads (Col. 2, Lns. 33-45), a first portion of a tubular structure in form of to top of the hosel fitting (Fig. 5) affixed to a shaft (Fig. 4), a second portion of a tubular structure in form of to bottom of the hosel fitting (Fig. 5) received by a shaft receiving bore in a head (Fig. 4), a second portion extending downwardly into a shaft receiving bore (Fig. 4), a female fastener receiving portion (45) for receiving a bolt fastener (48) configured to affix a hosel to a plurality of heads, a shaft receiving bore (30), hosel fitting and shaft being in line (Figs. 1-5), a second portion of the tubular structure contacts a base of a shaft receiving bore (Fig. 4), a shaft receiving bore configured to orient a shaft properly to a head when the shaft is connected to the head using a hosel fitting (Col. 4, Lns. 15-21), different shafts (Col. 4, Lns. 52-58), a recess below the bore so the fastener will not strike the ground (Fig. 4), a wood type head (Figs. 1-2), a face plate on a head (Fig. 3), a bore having an aperture in the base and a fastener extends through the aperture (Fig.

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4), heads having different sizes, weights, peripheral weighting, volumes, roll and bulge, combinations (Col. 5, Lns. 1-9), center of gravity, and face plates (Col. 4, Lns. 15-50) in order to fit different heads and/or different shafts to a club (Abstract).

In view of the patent of Ashcraft it would have been obvious to modify the golf assembly of Vincent to have a head having a bore, a fastener, a hosel fitting a first portion of a tubular structure configured to be affixed to the end of the shaft, a second portion of the tubular structure received by a bore in a head, a second portion extending downwardly into a bore, a female fastener receiving portion for receiving a bolt fastener configured to affix a hosel fitting to a head, a bore, hosel fitting and shaft being in line, a second portion of the tubular structure contacts a base of a shaft receiving bore, a fastener allowing the exchange of different shafts, a recess below the bore so the fastener will not strike the ground, a wood type head, a bore having an aperture in the base and a fastener extends through the aperture to mate with the fastener receiving portion, a bore configured to orient a shaft properly when a shaft is connected to the head with the hosel fitting, a fastener configured to allow the head to be exchanged with different heads, and heads having different center of gravities in order to fit different heads and/or different shafts to a club.

Response to Arguments

10. The argument that the Applicant provided objected evidence of non-obviousness in the form of declarations is not agreed with. The Examiner was unable to find any

declarations in the case. Due to the length of the case the Examiner may have missed finding them and request a date in which they were filed. The argument that Vincent fails to disclose using inserts of a given weight in the crown and sole configured to achieve a desired center of gravity is disagreed with. Vincent does disclose using inserts and these inserts do have a given weight which will produce a desired center of gravity since the head of Vincent will have a center of gravity. The argument that Ryan is improper since Ryan discloses moving a center of gravity vertically but it would change the overall weight of the head is agreed with. Ryan also shows how to move weights between the heel and toe and thus move the center of gravity horizontally without changing the overall weight of a head. Clearly this principal is able to be used vertically as well. The argument that it is improper to use McCabe because McCabe does not disclose moving the center of gravity vertically by changing weights is disagreed with. McCabe was used to show that it is desired to change the center of gravity vertically without changing the overall weight of a head. Vincent showed how sole and crown inserts are able to be used to produce the desired weight distribution of a head. Ryan shows how to move weight inserts about a head without changing the overall weight of a head. Clearly one skilled in the art would see it obvious to perform the teaching of Ryan in the vertical direction as well. The argument that it is improper to use the reference of McCabe due to McCabe's primary purpose is to change the swing weight is disagreed with. Once McCabe fixes the swing weight McCabe discloses the teaching of moving the center of gravity vertically without effecting the overall weight of a head (Col. 5, Lns. 20-32). Clearly that teaching is able to be used with the head of

Vincent which utilizes crown and sole weight inserts which will effect the center of gravity of the head depending on what crown and sole inserts are selected. The argument that Vincent in view of Ryan and McCabe are improper due to the noted companies which are recently producing the invention as claimed is disagreed with. From the Jennifer Gardner article the Examiner was not able to see anything in the drawing and read anything in the article that discussed sole and crown inserts. In addition, a few of the references do not even have date associated to as the Taylor Made's web site so the Examiner is unable to consider them as whether they are prior art or not. The argument that Sahm is improper due to teaching changing swing weight is disagreed with. Saham teaches much more than just changing swing weight. Saham teaches changing the weighting of a head (Col. 1, Lns. 50-55). Clearly that includes keeping the overall weight the same and moving the center of gravity from toe to heel and even top from bottom on some embodiments (Figs. 1, 9). Saham even shows an example of keeping the overall weight the same but changing the placement of the different weight inserts. The argument that Saham does not disclose the ability of changing the vertical center of gravity without changing the overall weight is noted. Figure 1 may see a small change in vertical height of the center or gravity as different weights are moved around. But clearly McCabe discloses that this is important to be able to do.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Slb/ 24 March 2008

/Stephen L. Blau/
Primary Examiner, Art Unit 3711